

Serial No. 09/803,996

**REMARKS**

Favorable reconsideration of this application, in light of the following discussion and in view of the present amendment, is respectfully requested.

Claims 1, 2 and 5-12 are pending and under consideration. Claims 3 and 4 are canceled without prejudice and claims 1, 6-8, 11 and 12 are amended by the present amendment.

**I. Rejections under 35 USC § 112**

Claims 2 and 6 were rejected under 35 USC § 112, second paragraph as indefinite. This rejection is respectfully traversed.

Claims 2 and 6 both depend on claim 1, and recite "The book management apparatus according to claim 1," which sets forth an apparatus similarly to independent claim 1. Claims 2 and 6 recite functional language in relation to claimed structural features of independent claim 1, which functional language is different from a method step.

Moreover, it is respectfully submitted functional language recited in an apparatus claim (such as claims 2 and 6) is not per se improper. For example, MPEP 2173.05 (g) states:

There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

Accordingly, it is respectfully submitted claims 2 and 6 meet the requirements of 35 USC § 112, second paragraph, and it is respectfully requested this rejection be withdrawn.

Claims 4 and 5 were rejected under 35 USC § 112, second paragraph as unclear with respect to the terms "collation" and "collated". This rejection is also respectfully traversed.

Independent claims 1, 11 and 12 are amended to include similar features to claim 4 (and claim 4 is accordingly canceled).

Further, it is respectfully submitted the meaning of the terms "collation" and "collated" are clear at least in light of the specification at page 25, lines 16-25. Accordingly, it is respectfully requested this rejection also be withdrawn.

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**II. Rejections to Independent Claims 1, 11 and 12**

Claims 1, 2, 8, 9, 11 and 12 were rejected under 35 USC § 102(a) as unpatentable over Epixtech; claims 1, 8, 11 and 12 were rejected under 35 USC § 102(b) as unpatentable over US patent number 4,153,931 to Green et al (herein "Green"); and claims 3, 4, 6 and 8 were rejected under 35 USC § 103(a) as unpatentable over Green and "MIT Report to the President 1994-95" (herein "MIT"). These rejections are respectfully traversed.

Initially, it is noted independent claims 1, 11 and 12 are amended to recite similar features as claims 3 and 4 (and claims 3 and 4 are accordingly cancelled). Amended independent claim 12 recites:

... managing ordering information on books newly ordered from the individual libraries; placing an order with a book wholesaler, based on the managed ordering information; receiving collation information derived when an ordered book is accessioned by a corresponding library; and transmitting the received collation information to the wholesaler.

Independent claims 1 and 11 are amended to recite similar features.

In a non-limiting example, after the ordered books are delivered to a recipient library, a collating operation is performed. As a result, the "Status of Possession" in a possession database may be rewritten from "Not Collated" to "Possessed," so that the books are made open to access and can be lent thereafter. Also, the wholesaler-side server may be notified that the collation has been completed, and corresponding items in the received/placed order database rewritten to indicate completion of the collating process (see the specification at page 25, line 16 to page 26, lines 2).

As an advantage, the importance of previously published books or newly published books can be judged from various angles, so that books meeting users' needs can be selected. Further, orders from several libraries can be lumped, and therefore books can be purchased at reduced prices according to the numbers of copies ordered (see the specification at page 26, lines 9-16).

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In contrast, Epixtech only discusses a "Resource Sharing System" which "automates the borrowing and lending activity within a library by linking with local systems, remote library catalogs, messaging utilities, and commercial document suppliers using industry standards and protocols." Epixtech only broadly discusses automating borrowing and lending activity, but does not discuss or suggest at least "placing an order with a book wholesaler, based on the managed ordering information," as recited in amended independent claim 12, for example. Further, Epixtech does not discuss or suggest "receiving collation information derived when an ordered book is accessioned by a corresponding library" and "transmitting the received collation information to the wholesaler," as recited in amended independent claim 12.

Accordingly, it is respectfully submitted amended independent claims 1, 11 and 12 and each of the claims depending therefrom patentably distinguish over Epixtech.

Moreover, Green only discusses a system in which users are given a unique identifier, and centralized borrowing records are kept. However, Green does not discuss or suggest "order information management means and ordering means," as acknowledged in the outstanding Office Action at page 4.

Further, MIT only discusses a searchable database of USMARC format bibliographic records for internet-accessible materials, but does not discuss or suggest "managing ordering information on books newly ordered from the individual libraries; placing an order with a book wholesaler, based on the managed ordering information; receiving collation information derived when an ordered book is accessioned by a corresponding library; and transmitting the received collation information to the wholesaler," as recited in amended independent claim 12.

Rather, MIT only discusses at page 3 that serial orders are placed on-line, but does not discuss or suggest transmitting received collation information to a wholesaler, as recited in amended independent claim 12.

Accordingly, it is respectfully submitted Green and MIT do not teach or suggest the features of amended independent claims 1, 11 and 12, and that amended independent claims 1, 11 and 12 and each of the claims depending therefrom patentably distinguish over Green and MIT.

### **III. Rejections of Dependent Claims 5, 7 and 10**

Claim 7 was rejected under 35 USC § 103(a) as unpatentable over Green, MIT and US patent number 6,078,897 to Rubin et al (herein "Rubin"). This rejection is respectfully traversed.

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Claim 7 depends on Independent claim 1, which as discussed is believed to patentable distinguish over Green and MIT. Further, Rubin only discusses accepting a proposed order for products or services and identifying additional orders that can be combined with the proposed order, but does not discuss or suggest "placing an order with a book wholesaler, based on the ordering information managed by the ordering information management means," as recited in amended independent claim 1.

Accordingly, it is respectfully submitted amended independent claim 1 and claim 7 depending therefrom also patentably distinguish over Green, MIT and Rubin.

Claim 5 was rejected under 35 USC §§ 102(a) and 103(a) as unpatentable over Epixtech, and claim 10 was rejected under 35 USC § 103(a) as unpatentable over Epixtech. These rejections are respectfully traversed.

Claims 5 and 10 depend on independent claim 1, which as discussed are believed to patentably distinguish over Epixtech. Accordingly, it is respectfully submitted claims 5 and 10 also patentably distinguish over Epixtech.

#### **IV. Amendments to the Claims**

In addition, claims 1, 11 and 12 are amended to better conform to standard claim drafting practice. Claims 6-8 are also amended to depend directly on independent claim 1. It is believed no new matter is added.

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**V. Conclusion**

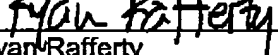
Consequently, in light of the above discussion and in view of the present amendment, this application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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